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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES

In re Application of: SOLOMON, et al.
Serial No.: 09/470,580
Filing Date: December 22, 1999
Group Art Unit: 3622
Examiner: Mussie Tesfamariam
Title: REBATE PROCESSING SYSTEM AND METHOD
OFFERING SELECTABLE DISBURSEMENT OPTIONS

BOARD OF PATENT APPEALS
AND INTERFERENCES

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Name: Willie Jiles

Willie Jiles

Date: February 28, 2003

Honorable Assistant Commissioner
for Patents
BOARD OF APPEALS AND INTERFERENCES
Washington, D.C. 20231

Dear Sir:

APPEAL BRIEF

Appellants have appealed to this Board from the decision of the Examiner, contained in a Final Office Action mailed October 2, 2002, finally rejecting Claims 1-38. Appellants mailed a Notice of Appeal on January 2, 2003. Appellants respectfully submit this Appeal Brief.

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REAL PARTY IN INTEREST

The real party in interest for this Application under appeal is Parago, Inc. of Dallas, Texas.

RELATED APPEALS AND INTERFERENCES

The Appellants, the undersigned Attorney for Appellants, and the Assignee know of the following application on appeal that may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal: United States Patent Application Serial No. 09/470,582, filed on December 22, 1999, appeal filed on November 22, 2002.

STATUS OF CLAIMS

Claims 1-38 were rejected in the Final Office Action mailed October 2, 2002. Claims 1-38 are all presented for appeal and are set forth in Appendix A.

STATUS OF AMENDMENTS

Appellants made no amendments to the claims after the Final Office Action.

SUMMARY OF INVENTION

Traditional rebates offer cash back to customers who fulfill a set of requirements after purchasing a product. *Specification*, at p. 2, ll. 2-18. For example, after purchasing a computer bearing a rebate, the purchaser may submit physical documentation to receive cash back from the computer manufacturer. These post-purchase requirements give rebate programs an advantage over other types of product discounts, such as coupons. For example, since coupon discounts apply at product purchase, the customer pays a reduced price at the purchase. With a rebate, the customer pays full price and then must perform tasks to receive the rebate. If the customer fails to appropriately perform the tasks, the rebate is never paid. Therefore, a rebate can generate a sale without ever being redeemed, whereas a coupon that generates a sale is inherently used to discount the purchase price.

The present invention encompasses a number of embodiments for automating, consolidating, and streamlining rebate processes, while maintaining key aspects of rebate programs that provide enhanced value. *Id.*, at p. 3, ll. 2-11. A rebate processing center

provides a unified system for managing information relating to rebate promotions, processing rebate requests, and interfacing with rebate sponsors and consumers. *Id.*, at p. 8, l. 21 - p. 9, l. 8. According to particular embodiments, the rebate processing center enables consumers to select between various disbursement options for receiving an authorized rebate. *Id.*, at p. 12, ll. 12-23 and Fig. 9. For example, the disbursement options for a rebate may include \$5.00 cash back or a \$15.00 purchase credit. By providing options with different cash values to the recipient, the rebate processing center can incent consumers to choose options other than cash. This can, in turn, drive increased sales while maintaining consumer satisfaction.

ISSUES

I. Whether Claims 1-6, 8-16, 18-26, 28-34, and 36-38 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 5,729,693 to Holda-Fleck ("Holda-Fleck") in view of U.S. Patent No. 6,223,168 to McGurl, et al. ("McGurl").

II. Whether Claims 7, 17, 27, and 35 are unpatentable under 35 U.S.C. § 103(a) over the combination of *Holda-Fleck*, *McGurl* and U.S. Patent No. 6,052,675 issued to Checchio ("Checchio").

GROUPING OF CLAIMS

For purposes of this Appeal, Appellants request the following claim groupings for the two issues presented:

- I. For this issue, all claims stand or fall together.
- II. For this issue, all claims stand or fall together.

ARGUMENT

I. Claims 1-6, 8-16, 18-26, 28-34, and 36-38 are patentable over *Holda-Fleck* and *McGurl*, and the proposed combination is inappropriate.

A. *Holda-Fleck* and *McGurl*, whether taken alone or in combination, fail to teach or suggest all elements of Claims 1-6, 8-16, 18-26, 28-34, and 36-38.

Appellants' Claim 1 recites:

A computer-based interface for facilitating rebate processing, the interface operable to:

receive authorization of a rebate request;

display rebate information retrieved from a remote rebate processing center, the rebate information comprising at least two disbursement options, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and

receive a selection of the disbursement options.

Appellants respectfully submit that *Holda-Fleck* and *McGurl*, taken alone or in combination, fail to teach or suggest all elements of Appellants' claims. For example, Claim 1 includes:

... rebate information comprising at least two disbursement options, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value

None of the cited references teach or suggest these aspects of Claim 1. The Examiner admits, on page 2 of the Office Action, that *Holda-Fleck* fails to even contemplate multiple disbursement options, let alone the particularly identified portions of Claim 1. As teaching of these aspects of Claim 1, the Examiner relies on *McGurl*. *McGurl* discloses a system that facilitates remittance of payments via one or more delivery mechanisms. *McGurl*, at col. 1, ll. 11-15. In particular, *McGurl* teaches the delivery of payments using either electronic funds transfer (EFT) or transmittal of negotiable instruments, based on selections by users. *Id.*, at col. 4, l. 37 - col. 5, l. 18. For example, in describing the system, *McGurl* contemplates users selecting between methods of disbursement, and identifies this as a selection between

"whether the disbursement is desired by EFT or printed negotiable instrument." *Id.*, at col. 5, ll. 10-11. However, *McGurl* fails to contemplate the disbursement options of Appellants' Claim 1. Moreover, *McGurl* does not teach or suggest "a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value." Thus since neither cited reference teaches or suggests the identified aspects of Claim 1, the rejection under 35 U.S.C. § 103(a) is inappropriate.

Appellants' independent Claims 11, 21, and 31 each include limitations that, for reasons similar to those discussed with respect to Claim 1, are not taught or suggested by the cited references. Therefore, Appellants respectfully request reconsideration and withdrawal of the rejection to Claims 1, 11, 21, and 31 and their respective dependent Claims.

B. The proposed combination of *Holda-Fleck* and *McGurl* is inappropriate because the references teach away from a combination, the proposed combination renders the references unsatisfactory for their intended purpose, and the Examiner has identified no suggestion or motivation for the combination.

Appellants' submit that the combination of *Holda-Fleck* and *McGurl* is inappropriate for at least three reasons. First, *Holda-Fleck* and *McGurl* teach away from a combination. The fact that a prior art device could be modified so as to produce the claimed invention is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. *Carella v. Starlight Archery*, 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986). In addition, a prior art reference must be considered in its entirety, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

In general *Holda-Fleck* discloses a system for automatically crediting a rebate to a customer over a telephone network. *Holda-Fleck*, Abstract. A primary advantage identified by *Holda-Fleck* is the automatic crediting of the rebate amount to a consumer's telephone

bill. *Id.*, at col. 3, ll. 34-41. *Holda-Fleck* specifically identifies prior art rebate delivery techniques that involve the selection between EFT and paper delivery of rebates. *Id.*, at col. 2, ll. 32-34. *Holda-Fleck* states that such a system “only partially dispenses with the need for paper processing of rebates, since the consumer without an appropriate bank account will still require the issuance of a check in order to collect his funds.” *Id.*, at col. 2, ll. 34-38. *Holda-Fleck* overcomes this problem using the automatic delivery of a rebates to consumers’ phone bills. Thus *Holda-Fleck* explicitly teaches away from a combination with *McGurl*.

Second, the combination of the teachings of *McGurl* with *Holda-Fleck* renders *Holda-Fleck* unsatisfactory for its intended purpose. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). *Holda-Fleck* proposes automation and simplification of rebate requests by crediting rebates to customers’ telephone bills. *Holda-Fleck*, at col. 3, ll. 2-32. The introduction of disbursement selections, and in particular the introduction of paper delivery of payments as taught by *McGurl*, simply reintroduces problems that *Holda-Fleck* intends to overcome. At the very least, this modification would change the principle of operation of *Holda-Fleck*, which is similarly unacceptable.

Third, the Examiner has not shown the required suggestion or motivation in the references or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine the cited references. The mere fact that the prior art may be combined in the manner suggested by the Examiner does not make the combination obvious unless the prior art suggested the desirability of the combination. *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992). Thus, the mere fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine.¹ Nothing in *Holda-Fleck*, *McGurl*, or any other cited reference suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests the proposed combination.² Speculation in hindsight that it would have been

¹ The Examiner addresses the motivation for the combination in two separate actions: the First Office Action mailed on January 30, 2002, and the Final Office Action. In both instances, the Examiner merely asserts that the combination would improve *Holda-Fleck*. See *First Office Action* at p. 3-4; *Final Office Action* at p. 3.

² Appellants’ previously objected to the proposed combination, to which the Examiner responded at page 12 of the Final Office Action that “the applicant argues the combination of these references is inappropriate. The Examiner disagrees. Because *Holda-Fleck* and *McGurl* combined together address the core of the invention.”

obvious to make the proposed combination because the proposed combination would be helpful is insufficient.³

For at least all of these reasons, the combination of these references is inappropriate and thus cannot support the rejection. Moreover, even if the combination is appropriate, Appellants have shown above that *Holda-Fleck* and *McGurl*, alone or in combination, fail to teach or suggest all elements of Appellants' Claims. Therefore, Appellants respectfully request the Board to reconsider and reverse the Examiner's rejection.

II. Claims 7, 17, 27, and 35 are patentable over *Holda-Fleck*, *McGurl* and *Checchio*, and the proposed combination is inappropriate.

The Examiner rejects Claim 7, 17, 27, and 35 under 35 U.S.C. § 103(a) as being unpatentable over the combination of *Holda-Fleck*, *McGurl* and *Checchio*. The Examiner introduces *Checchio* for the concept of using a credit card to cover costs that exceed a purchase credit. However, *Checchio* fails to introduce any of the elements of Appellants' independent claims that are not shown by *Holda-Fleck* or *McGurl*. Moreover, this combination of references is similarly inappropriate as with the combination of *Holda-Fleck* and *McGurl*, as discussed above. Therefore, Appellants respectfully request reconsideration and withdrawal of the rejection to Claims 7, 17, 27, and 35, which depend from independent claims shown above to be allowable.

³ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].").

CONCLUSION

Appellants have demonstrated that the present invention, as claimed in Claims 1-38, is patentably distinct from the cited art. Accordingly, Appellants respectfully request that the Board reverse the final rejection of the Examiner and instruct the Examiner to issue a Notice of Allowance of Claims 1-38.

Appellants submit this Appeal Brief is being in triplicate and enclose a check in the amount of \$160.00 to cover the fee. The Commissioner is hereby authorized to charge any extra fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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APPENDIX A - CLAIMS PRESENTED ON APPEAL

1. A computer-based interface for facilitating rebate processing, the interface operable to:

receive authorization of a rebate request;

display rebate information retrieved from a remote rebate processing center, the rebate information comprising at least two disbursement options, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and

receive a selection of the disbursement options.

2. The computer-based interface of Claim 1, further operable to:

display a plurality of product identifiers, wherein each of the product identifiers is associated with a product bearing a rebate;

receive purchase information from a user, wherein the purchase information identifies a purchased product associated with a selected one of the product identifiers; and

wherein the disbursement options are determined based on the purchase information.

3. The computer-based interface of Claim 2, further operable to:

receive a search string; and

display the product identifiers responsive to the search string.

4. The computer-based interface of Claim 1, wherein the rebate request comprises a request for a rebate on a purchased product, and the disbursement options comprise a plurality of products related to the purchased product available to purchase using a rebate credit.

5. The computer-based interface of Claim 1, further operable to display status information, wherein the status information comprises a current status of a rebate transaction.

6. The computer-based interface of Claim 1, further operable to:
display a plurality of products available to purchase using a credit associated with a selected one of the disbursement options;
receive purchase selections from the plurality of products; and
display a total price of the purchase selections.

7. The computer-based interface of Claim 6, further operable to receive credit card information from the user if the total price exceeds the credit.

8. The computer-based interface of Claim 1, wherein the interface comprises a site browser and further operable to display an additional site for purchasing products using a credit associated with a selected one of the disbursement options.

9. The computer-based interface of Claim 1, wherein the disbursement options comprise a cash rebate and a credit voucher.

10. The computer-based interface of Claim 1, wherein the credit voucher comprises a selected one of a retailer gift certificate, a manufacturer credit voucher, and a credit valid for an Internet purchase.

11. A method for processing a rebate, comprising:
receiving authorization of a rebate request;
displaying rebate information retrieved from a remote rebate processing center, the rebate information comprising at least two disbursement options, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and

receiving a selection of the disbursement options.

12. The method of Claim 11, further comprising:
displaying a plurality of product identifiers, wherein each of the product identifiers is associated with a product bearing a rebate;
receiving purchase information from a user, wherein the purchase information identifies a purchased product associated with a selected one of the product identifiers; and
receiving consumer information from the user; and
communicating the consumer information to the remote rebate processing center to initiate the rebate request.

13. The method of Claim 12, further comprising:
receiving a search string; and
displaying the product identifiers responsive to the search string.

14. The method of Claim 11, wherein the rebate request comprises a request for a rebate on a purchased product, and the disbursement options comprise a plurality of products related to the purchased product available to purchase using a rebate credit.

15. The method of Claim 11, further comprising displaying status information, wherein the status information comprises a current status of a rebate transaction.

16. The method of Claim 11, further comprising:
displaying a plurality of products available to purchase using a credit associated with a selected one of the disbursement options;
receiving purchase selections from the plurality of products; and
displaying a total price of the purchase selections.

17. The method of Claim 16, further comprising receiving credit card information from the user if the total price exceeds the credit.

18. The method of Claim 11, further comprising linking to a site for purchasing products using a credit associated with a selected one of the disbursement options.

19. The method of Claim 11, wherein the disbursement options comprise a cash rebate and a credit voucher.

20. The method of Claim 11, wherein the credit voucher comprises a selected one of a retailer gift certificate, a manufacturer credit voucher, and a credit valid for an Internet purchase.

21. A rebate processor, comprising:

a memory operable to store a promotion comprising at least two disbursement options, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and

a processor, operable to:

receive a rebate request;

match the rebate request to the promotion;

communicate an authorization of the rebate request, wherein the authorization comprises the disbursement options; and

receive a selection of the disbursement options.

22. The rebate processor of Claim 21, wherein:

the promotion further comprises a first promotion identifier;

the rebate request comprises a second promotion identifier; and

the processor is further operable to match the rebate request to the promotion based on a comparison of the first promotion identifier and the second promotion identifier.

23. The rebate processor of Claim 21, wherein the processor is further operable to:
receive purchase information from a consumer; and
identify the promotion based on the purchase information.

24. The rebate processor of Claim 21, wherein the rebate request comprises a request for a rebate on a purchased product, and the disbursement options comprise a plurality of products related to the purchased product available to purchase using a rebate credit.

25. The rebate processor of Claim 21, wherein the memory is further operable to store status information, wherein status information comprises a current status of the rebate request.

26. The rebate processor of Claim 21, wherein the processor is further operable to:
communicate a product list, wherein the product list comprises a plurality of products available to purchase using a credit associated with a selected one of the disbursement options;
receive purchase selections from the product list; and
display a total price of the purchase selections.

27. The rebate processor of Claim 26, wherein the processor is further operable to receive credit card information from the user if the total price exceeds the credit.

28. The rebate processor of Claim 21, wherein the processor is further operable to communicate a location of a site for purchasing products using a credit associated with a selected one of the disbursement options.

29. The rebate processor of Claim 21, wherein the disbursement options comprise a cash rebate and a credit voucher.

30. The rebate processor of Claim 21, wherein the credit voucher comprises a selected one of a retailer gift certificate, a manufacturer credit voucher, and a credit valid for an Internet purchase.

31. A method for processing a rebate, comprising:
receiving purchase information identifying a product bearing a rebate;
communicating the purchase information to a remote rebate processing center;
receiving rebate information describing the rebate from the remote rebate processing center, the rebate information comprising at least two disbursement options, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and
displaying the rebate information.

32. The method of Claim 31, further comprising:
receiving consumer information from the user; and
communicating the consumer information to the remote rebate processing center to
initiate a rebate request.

33. The method of Claim 31, wherein the disbursement options comprise a list of
products available to purchase using a rebate credit, wherein the list is determined based on
the purchase information.

34. The method of Claim 31, further comprising:
displaying a plurality of products available to purchase using a credit associated with
a selected one of the disbursement options;
receiving purchase selections from the plurality of products; and
displaying a total price of the purchase selections.

35. The method of Claim 34, further comprising receiving credit card information
from the user if the total price exceeds the credit.

36. The method of Claim 31, further comprising linking to a site for purchasing
products using a credit associated with a selected one of the disbursement options.

37. The method of Claim 31, wherein the disbursement options comprise a cash
rebate and a credit voucher.

38. The method of Claim 31, wherein the credit voucher comprises a selected one of a retailer gift certificate, a manufacturer credit voucher, and a credit valid for an Internet purchase.